

Notice of Allowability

Application No.

10/088,250

Examiner

Golam M. M. Shameem, Ph.D.

Applicant(s)

FINK ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/29/2005.
2. ☒ The allowed claim(s) is/are 1-3, 6, 11, 16-21, 88-95, 113-114, 119-120, 124-125 and 137-139 (now 1-28).
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date 11/29/2005
- ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
- ☒ Examiner's Amendment/Comment
- ☒ Examiner's Statement of Reasons for Allowance
- ☐ Other _____

DETAILED ACTION

Status of Claims

This communication is in response to the Request for continued examination (RCE) filed on 11/29/2005.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/29/05 has been entered.

Priority

This application is a 371 of PCT/US00/24962 09/13/2000, which claims benefit for domestic priority under 35 U.S.C. § 119(e) [to a provisional application 60/229,355 09/14/1999], is acknowledged.

Status of Claims

Claims 1-139 are pending in the application.

Receipt is acknowledged of amendment / response filed on November 29, 2005 and that has been entered.

Claims 4-5, 7-10, 12-15, 22-87, 96-112, 115-118, 121-123 and 126-136 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142 (b) as being drawn to a non-elected subject matter.

Applicant's arguments and amendments have been fully considered and found partially persuasive (see below Examiner's amendment) with respect to the objection of claims 4-120 and

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the objection is hereby withdrawn. In view of a fair interpretation of the claims, the Examiner will rejoin method of making claims, claims 137-139 to the elected invention, because they fall within the scope of elected invention and therefore, the restriction requirement has been withdrawn and all remaining pending claims 1-3, 6, 11, 16-21, 88-95, 113-114, 119-120, 124-125 and 137-139 are now allowable over the prior art of record.

Examiner's amendment

An Examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this Examiner's amendment was provided by Applicant's Attorney Ms. Barbara Kurys (Response filed on November 29, 2005, Remarks, page 14).

The application has been amended as follows:

- a. Claims 4-5, 7-10, 12-15, 22-87, 96-112, 115-118, 121-123 and 126-136 have been canceled.

Reasons for allowance

The following is an Examiner's statement of reasons for allowance:

Claims 1-3, 6, 11, 16-21, 88-95, 113-114, 119-120, 124-125 and 137-139 are being allowed since the instantly claimed compounds are neither obvious nor anticipated by the prior art and there is no suggestion or motivation to modify the compounds of any prior art to obtain the instantly claimed invention. Therefore the instant claims 1-3, 6, 11, 16-21, 88-95, 113-114, 119-120, 124-125 and 137-139 are allowable over the prior art of record.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Monday-Thursday from 7:30 AM - 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7922. The Official fax phone numbers for this Group are (571) 273-8300. When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR only. For more information about the

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pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

Golam M M Shameem, Ph.D.
Primary Examiner
Art Unit 1626
Technology Center 1600

A handwritten signature in black ink, appearing to read 'G. M. Shameem', with a stylized, cursive script.

GOLAM M. M. SHAMEEM, PH.D
PRIMARY EXAMINER

January 31, 2006